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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/768,337	01/30/2004	Mark Ferraro	770P011329-US (PAR)	6516

7590 11/30/2004
Perman and Green, LLP
425 Post Rd.
Fairfield, CT 06824

EXAMINER

COSIMANO, EDWARD R

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 11/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/768,337

Applicant(s)

FERRARO, MARK

Examiner

Edward R. Cosimano

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

1. Applicant should note the changes to patent practice and procedure:
 - A) effective December 01, 1997 as published in the Federal Register, Vol 62, No. 197, Friday October 10, 1997;
 - B) effective November 07, 2000 as published in the Federal Register, Vol 65, No. 54603, September 08, 2000; and
 - C) Amendment in revised format, Vol. 1267 of the Official Gazette published February 25, 2003.
2. Applicant's claim for the benefit of an earlier filing data under 35 U.S.C. § 119(e).
3. The oath or declaration is defective. A new oath or declaration in compliance with 37 C.F.R. § 1.67(a) identifying this application by its Serial Number and filing date is required. See M.P.E.P. §§ 602.01 and 602.02.
 - 3.1 The oath or declaration is defective because:
 - A) the declaration does not mention the claim for the benefit of an earlier filing date as set forth in paragraph number 1 on page 1, "[001] This application claims the benefit of U.S. Provisional Application No. 60/469,980, filed May 13, 2003."
4. The disclosure is objected to because of the following informalities:
 - A) applicant must update:
 - (1) the continuing data in paragraph number 1 on page 1, with the current status of each of the referenced applications, e.g., --now abandoned--, or --now patent #?--, or --which is abandoned and now serial number #?--, --which is expired--, etc.
 - B) the following errors have been noted in the specification:
 - (1) at line 10 of paragraph number 6 on page 2, applicant's use of the phrase "... the operating software of the postage meter, that that such modification can be accomplished remotely ...", is confusing since either some words are missing or this paragraph should read as --[006] Furthermore, it is desirable that such a postage meter system have the ability to update aspects of its operating software remotely via a communications system such as the Internet or a modem link to a remote control center. The communications

~~system, as well as the associated postage meter may incorporate transmission~~
techniques to assure that the communication of the data is secure. Also, it would be advantageous that, in the event that there is a need for modification of the operating software of the postage meter, ~~[[that]]~~ that such modification can be accomplished remotely by the transmission of signals via the communications system, instead of a need for recalling the postage meter for modification or replacement with a new updated model.--.

(2) at lines 11-12 of paragraph number 21 on pages 8-9, applicant's use of the phrase "... a subtract the 78 to present ...", is confusing since either some words are missing or this paragraph should read as --[0021] For the payment of the postage, the postal facility 30 transmits to the receiver 34 an authorization for dispensing an amount of postage for which payment has been made, the amount of the authorized postage being stored in a memory 74. The amount of postage dispensed by the postage selection circuit 46 is monitored by an accumulator 76 which sums the successive amounts of postage being dispensed. The difference between the amount of the authorized postage, as stored in the memory 74, and the amount of the dispensed postage, as provided by the accumulator 76, and subtracted by a ~~[[subtract the]]~~ subtractor 78 to present the remaining amount of available postage on a display 80.--.

Appropriate correction is required.

5. The specification and drawings have not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification or drawings. Applicant should note the requirements of 37 CFR § 1.74, § 1.75, § 1.84(o,p(5)), § 1.121(a)-1.121(f) & § 1.121(h)-1.121(i).

6. 35 U.S.C. § 101 reads as follows:

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof,
~~may obtain a patent therefore, subject to the conditions and requirements of this title".~~

6.1 ~~Claims 1-8 are rejected under 35 U.S.C. § 101 because the invention as claimed is~~ directed to non-statutory subject matter, since they fail to comply with the "requirements this title, namely 35 U.S.C. § 102 as set forth below.

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7.1 Claims 1-8 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Wright et al (4,802,218).

7.1.1 In regard to claims 1-8, Wright et al ('218) discloses a computerized postage metering system that includes programmed computer 30 and computer controlled printer 40. Under the control of a postage metering operating program that has been supplied by the manufacture and Post Office, computer 30 would use the weight of an item to be shipped as manually entered by the operator using keyboard 31 or automatically obtained from a scale 53 and postage rate data stored in a manually inserted card 90 to determine the correct amount of postage for the item being shipped. After determining the required postage for the item to be shipped, computer 30 requests a postage indicia for the required amount of postage from a manually inserted smart card 10 as evidence that the required amount of postage has been paid. Smart card 10, which contains the postage accounting information associated with the user, determines if the user has sufficient prepaid postage funds to pay for the required postage amount, and if there are sufficient funds then smart card 10 would authorize the generation of a postage indicia comprising both human readable or alphanumeric information and machine readable coded information. Where the information contained in the postage indicia that is printed in both human readable and machine readable form as taught by Wright et al ('218) would include the required alphanumeric postage related information, in the form of date 73 and postage amount 72 and machine readable authentication information in the form of coded

information 83a,83b. It is noted that as taught by Wright et al ('218) and as can be seen in figs. 6a and 6b, the postage indicia data used to generate the authentication information:

A) is coded or encoded using a previously obtained and stored coding method that uses an issuer, or remotely, selected encryption key and encryption program; and

B) may be printed in human readable and/or machine readable form, where the machine readable form may include a barcode or a multi-dimensional coded.

It is further noted that the smart card of Wright et al ('218) may be used to download new rate and program data into the postage metering system from a remote source.

8. The examiner has cited prior art of interest, for example:

A) Allocca et al (4,138,735) disclose that data to be used by a postage metering system when determining the correct postage amount for an item may be downloaded using RF transmissions or by modem.

B) Eckert (4,649,266) disclose the content of a postage indicia.

C) Haines et al (5,077,660) discloses the use of encrypted information to remotely configure a meter, where the encrypted number would permit the meter to enable and disable various features of the meter.

D) Abumehdi (5,508,933) discloses the use of encryption and an encryption key when generating a postage indicia based on data from the postage indicia and the accounting unit after which the indicia is printed line by line until the indicia has been completely printed.

E) Lee et al (5,606,613) disclose the use of a key manager which periodically changes the encryption key that used to authenticate print data sent from an accounting unit to the printer by decrypting and printing the received print data is the print data is authenticated.

F) Gilham (EP 0862145) disclose that that an encryption key is used to generate the authentication data printed in a postage indicia.

G) the Office systems article discloses that the new postage meters use encryption to authenticate postage indicia as well as print personalized messages/images and barcodes as part of the postage indicia on items of mail.

H) Cordery et al (5,567,794) discloses that he encryption key used to encrypt authentication data may be downloaded from a remote device.

9. The shorten statutory period of response is set to expire 3 (three) months from the mailing date of this Office action.


10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward Cosimano whose telephone number is (703) 305-9783. The examiner can normally be reached Monday through Thursday from 7:30am to 6:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss, can be reached on (703)-308-2702. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

10.1 The fax phone number for UNOFFICIAL/DRAFT FAXES is (703) 746-7240.

10.2 The fax phone number for OFFICIAL FAXES is (703) 872-9306.

10.3 The fax phone number for AFTER FINAL FAXES is (703) 872-9306.

11/19/04


Edward R. Cosimano
Primary Examiner A.U. 3629